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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,538	05/02/2002	Audrey Goddard	P3230R1C001-168	1052

30313 7590 03/31/2005

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EXAMINER

SEHARASEYON, JEGATHEESAN

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/063,538	EATON ET AL.	
	Examiner	Art Unit	
	Jegatheesan Seharaseyon	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/29/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment and Declarations under 37 CFR § 1.132, both submitted 29 September 2004, have been entered. Claims 1-10 are amended. Claims 1-13 are under examination in the instant Application.
2. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior Office action.
3. The Office acknowledges the receipt of the drawings on 5/2/2002.
4. The Office acknowledges the change in title.
5. The Office acknowledges the submission of the IDS dated 9/29/2004.
6. The Applicants have provided a copy of the sequence listing in response to the "Notice to Comply".
7. Applicants request for correction of inventorship under 37 CFR 1.48(b) is acknowledged.

Priority

8. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119. Applicants have argued that they are entitled to the benefit of the filing date of August 24, 2000 based on the disclosure in the PCT Application PCT/US00/23328 filed 8/24/2000 of the differential tissue expression distribution in tumor versus normal tissue (example 18). Although, the previous patent application discloses the same polypeptide (SEQ ID NO: 34) sequence as the instant specification, the disclosure is not enabling for the instant invention and therefore do not

impart utility to the claims of the current application. Therefore, the filing date of 2 May 2002 is maintained as the priority date.

35 U.S.C. § 112, first paragraph, Written Description withdrawn

9. The rejection of claim 6 under 35 U.S.C. § 112, first paragraph, Written Description, is *withdrawn*. Applicants amended claims to provide language pertaining to functional regions of SEQ ID NO: 34 that had been identified (i.e, "extracellular domains").

35 U.S.C. § 112, first paragraph, Enablement withdrawn

10. The rejection of claim 6 under 35 U.S.C. § 112, first paragraph, scope of enablement, is *withdrawn*. Applicants amended claims to provide language pertaining to functional regions of SEQ ID NO: 34 that had been identified (i.e, "extracellular domains").

35 USC § 112, second paragraph, withdrawn

11. The rejection of Claims 1-13 under 35 U.S.C. 112, second paragraph, for being indefinite is withdrawn. Applicants' amended current claims to disclose with location the "extracellular domain" (29 September 2004).

35 U.S.C. § 101/112, first paragraph,

Lack of Utility, Enablement, maintained

12. Claims 1-13 are rejected under 35 U.S.C. 101, as lacking utility. The reasons for this rejection under 35 U.S.C. § 101 are set forth at pp. 4-9 of the previous Office Action (29 September 2004). Claims 1-13 are also rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a specific

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and substantial asserted utility or a well established utility for the reasons set forth in the previous Office Action (29 September 2004), one skilled in the art clearly would not know how to use the claimed invention.

Applicants argue (29 September 2004, page 10) that the results presented in the instant specification are enabling for the polypeptide of SEQ ID NO: 34 (PRO1277).

They argue that the utilities of PRO1277 polypeptide include the use as a diagnostic tool, as well as therapeutically as a target for treatment, based on the data that

PRO1277 mRNA is more highly expressed in normal esophagus and skin compared esophageal tumor and melanoma tumor tissue. Applicant's arguments filed (29

September 2004) have been fully considered but are not found to be persuasive for the following reasons:

In the instant case, the specification provides data showing that polynucleotide is more highly expressed in normal esophagus and skin compared esophageal tumor and melanoma tumor tissue. However, there is no further supporting evidence to indicate that the polypeptide encoded by the polynucleotide of the instant invention is also differentially expressed in the normal tissue compared to the tumor tissue and as such one of skill in the art would conclude that it is not supported by a substantial asserted utility or a well-established utility. Contrary to Applicants assertion that PRO1277 is more highly expressed (29 September 2004, page 14, 2nd paragraph); Applicants only demonstrate more highly expressed mRNA for PRO1277 in normal esophagus and skin compared esophageal tumor and melanoma tumor tissue. There is no guidance in the specification as to how high the expression levels are (quantitative). Applicants provide

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no disclosure of the PRO1277 polypeptide expression. Applicants have provided no indication of the nature or the number of samples that were used in determining the expression levels. It is important to note that the instant specification provides no information regarding differential mRNA levels of PRO1277 in normal skin and esophagus tissues. The specification describes only mRNA expression data. The argument presented evinces that instant specification provides a mere invitation to experiment, and not readily available utility. Furthermore, as discussed extensively by Pennica et al. in the previous Office Action (28 June 2004, page 8), what is often seen is a *lack* of correlation between DNA amplification and increased protein expression. There is no description in the specification to that would indicate a correlation with higher expression levels of the message to the PRO1277 polypeptide. It remains that, there is no information on the record as to whether the claimed protein is expressed at all in the esophagus and skin tissue, cancerous or otherwise.

As discussed by Haynes et al (1998, Electrophoresis, 19: 1862-1871), polypeptide levels cannot be accurately predicted from mRNA levels, and that, according to their results, the ratio varies from zero to 50-fold (page 1863). The literature cautions researchers against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue. For example, Hu et al. (2003, Journal of Proteome Research 2: 405-412) analyzed 2286 genes that showed a greater than 1-fold difference in mean expression level between breast cancer samples and normal samples in a microarray (p. 408, middle of right column). Hu et al. discovered that, for genes displaying a 5-fold change or less in tumors compared to

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normal, there was no evidence of a correlation between altered gene expression and a known role in the disease. However, among genes with a 10-fold or more change in expression level, there was a strong and significant correlation between expression level and a published role in the disease (see discussion section). Chen et al. (2002, Molecular and Cellular Proteomics 1: 304-313) disclose that twenty-eight of the 165 protein spots (17%) or 21 of 98 genes (21.4%) had a statistically significant correlation between protein and mRNA expression (abstract). In addition, it is stated that no significant correlation between mRNA and protein expression was found ($r=-0.025$) if the average levels of mRNA or protein among all samples were applied across the 165 protein spots (98 genes). The reference also teaches that the mRNA/protein correlation coefficient also varied among proteins with multiple isoforms, indicating potentially separate isoform-specific mechanisms for the regulation of protein abundance. In this study using a quantitative analysis of mRNA and protein expression within the same lung adenocarcinomas, it is showed that only a subset of the proteins exhibited a significant correlation with mRNA abundance.

Given the increase in expressed message for PRO1277 in the normal esophagus and normal skin compared to esophageal tumor and melanoma tumor tissues, and the evidence provided by the current literature, it is clear that one skilled in the art would not assume that a more highly expressed would directly correlate with increased polypeptide levels. Further research needs to be done to determine whether the decrease of PRO1277 cDNA expression compared to normal esophagus and normal skin tissues supports a role for the peptide in the cancerous tissue; such a role has not

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been suggested by the instant disclosure. Such further research requirements make it clear that the asserted utility is not yet in currently available form, i.e., it is not substantial. This further experimentation is part of the act of invention and until it has been undertaken, Applicant's claimed invention is incomplete. As discussed in *Brenner v. Manson*, (1966, 383 U.S. 519, 148 USPQ 689), the court held that:

"The basic quid pro quo contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility", "[u]nless and until a process is refined and developed to this point-where specific benefit exists in currently available form-there is insufficient justification for permitting an applicant to engross what may prove to be a broad field", and,

"a patent is not a hunting license", "[i]t is not a reward for the search, but compensation for its successful conclusion."

Accordingly, the Specification's assertions that the claimed PRO1277 polypeptides have utility in the fields of cancer diagnostics and cancer therapeutics are not substantial.

The declarations of Mr. Grimaldi, filed under 37 CFR 1.132 (29 September 2004), is insufficient to overcome the rejection of claims 1-13, based upon 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph as set forth in the last Office action. Similarly, the declaration of Dr. Polakis, filed under 37 CFR 1.132 (29 September 2004), is insufficient to overcome the rejection of claims 1-13, based upon 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph as set forth in the last Office action. Likewise, the declaration of Dr. Ashkenazi, filed under 37 CFR 1.132 (29 September 2004), is insufficient to overcome the rejection of claims 1-13, based upon 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph as set forth in the last Office action because:

In the declaration filed under 37 CFR 1.132 (29 September 2004, originally filed in application serial number 10/063,557), senior research associate Mr. Grimaldi states (page 2, paragraph 5), that "data from pooled samples is more likely to be accurate than data obtained from a sample from a single individual". In addition, Mr. Grimaldi declaration on paragraphs 6 and 7 states that semi-quantitative analysis employed to generate the data of example 18 is sufficient to determine if a gene is over or under expressed in tumor cells compared to corresponding normal tissue. Further it asserted that that any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue. Mr. Grimaldi also asserted that, if a difference is detected, this indicates that the gene and its corresponding polypeptide and antibodies against the polypeptide are useful for diagnostic purposes, to screen samples to differentiate between normal and tumor tissues. It is further stated that additional studies can then be conducted if further information is desired. In paragraph 7, declarant indicates that the difference in the expression is expected to be reflected in the difference in the corresponding protein. However, this appears to be declarant's opinion, and is not supported by fact or evidence. There is no description in the specification to that would indicate a correlation with higher or lower expression levels of the message to the PRO1277 polypeptide. Furthermore, it remains that, as evidenced by Pennica et al., the issue is simply not predictable, and the specification presents a mere invitation to experiment.

Applicants citing the second Grimaldi declaration (exhibit 2) filed under 37 CFR § 1.132 argues that, "Those who work in this field are well aware that in the vast majority

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of cases, when a gene is over-expressed..... this same principal applies to gene under-expression." Again citing paragraph 5, Applicants contend that 'the detection of increased mRNA expression is expected to result in increased polypeptide expression, and detection of decreased mRNA expression is expected to result in decreased polypeptide expression. The detection of increased or decreased polypeptide expression can be used for the diagnosis and treatment."

At paragraph 4 of the second Grimaldi declaration (Exhibit 2), the declarant discusses mutations of Her2/Neu, and chromosomal translocations that are known to be associated with cancer, and states that "If the chromosomal aberration results in the aberrant expression of a mRNA and the corresponding gene product (the polypeptide) as they do in the aforementioned cases, then the gene product is a promising target for cancer therapy, for example, by the therapeutic antibody approach." This argument has been fully considered but is not deemed persuasive because it evinces that the instant specification provides a mere invitation to experiment, and not a readily available utility. The PRO 1277 gene, unlike Her2/Neu, has *not* been associated with tumor formation or the development of cancer, nor has it been shown to be predictive of such. Similarly, unlike t (5;14), no translocation of PR01277 is known to occur. All that the specification demonstrates is that the PRO1277 nucleic acid was more highly expressed in normal esophagus and skin tissue compared to esophageal and melanoma tumor tissues. No mutation or translocation of PRO1277 gene has been associated with esophageal or skin cancer. In the absence of any of the above information, all that the specification does is present evidence that the mRNA encoding PR01136 is present in higher levels

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in an unknown number of samples, and invite the artisan to determine the rest of the story. Such is insufficient to meet the requirements of 35 U.S.C. § 101 for the claimed polypeptides.

The Polakis declaration states that approximately 200 gene transcripts were identified that are present in human tumor cells at significantly higher levels than in control tissues and that antibodies have been developed that identify and could possibly be used to down regulate the PRO peptides. Dr. Polakis states that it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide. Dr Polakis characterizes the instances where such a correlation does not exist as exceptions to the rule. Only Dr. Polakis conclusions are provided in the declaration. There is no evidentiary support to Dr. Polakis' statement that it remains a central dogma in molecular biology that increased mRNA Levels are predictive of corresponding increased levels of the encoded polypeptide.

Applicants also refer to three additional articles (Orntoft et al., Hyman et al., and Pollack et al. as providing evidence that gene amplification generally results in elevated levels of the encoded polypeptide. Applicants characterize Orntoft et al. as teaching in general (18 of 23 cases) chromosomal areas with more than 2-fold gain of DNA showed corresponding increase in mRNA transcripts. Applicants further characterize Hyman et al. as providing evidence of a prominent global influence of copy number changes on gene expression levels. It is also claimed by the Applicants that Pollack et al. teach that 62% of highly amplified genes show moderately or highly elevated expression and that,

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on average, a 2-fold change in DNA copy number is associated with a 1.5-fold change in mRNA levels.

Orntoft et al. appear to have looked at increased DNA content over large regions of chromosomes and comparing that to mRNA and polypeptide levels from the chromosomal region. Their approach to investigating gene copy number was termed CGH. Orntoft et al. do not appear to look at gene amplification, mRNA levels and polypeptide levels from a single gene at a time. The instant specification reports data regarding cDNA amplification of individual gene, which may or may not be in a chromosomal region, which that is highly amplified. Orntoft et al. concentrated on regions of chromosomes with strong gains of chromosomal material containing clusters of genes (p.40). This analysis was not done for gene encoding PRO1277 polypeptide in the instant specification. That is, it is not clear whether or not PRO1277 is in a gene cluster in a region of a chromosome that is highly expressed. Therefore, the relevance, if any of Orntoft et al. is not clear. Hyman et al. also used CGH approach in their research. Less than half (44%) of highly amplified genes showed over expression (abstract). Polypeptide levels were not investigated. Therefore, Hyman et al. also do not support utility of the polypeptides of the instant invention. Pollack et al. using CGH technology, concentrate on large chromosome regions showing high amplification (p.12965). However, Pollack et al. did not investigate or show a relationship with amplification and polypeptide expression. In fact the authors caution that elevated expression of an amplified gene cannot alone be considered strong independent evidence of candidate oncogene's role in tumorigenesis. Thus, these references

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collectively do not teach as Applicants contend that there is a direct correlation between increased mRNA levels and increased levels of encoded protein. Accordingly, the Applicants' assertions that the PRO1277 polypeptides have utility in the cancer diagnostics are not substantial.

Applicants also contend that the claimed polypeptide would have diagnostic utility even if there is no positive correlation between gene expression and expression of the encoded polypeptide. Further, it is asserted that even if there was no correlation between gene expression and increased or decreased protein expression for PRO1277, the polypeptide encoded by a gene that is over-expressed or under expressed in cancer would still have credible, specific and substantial utility. Applicants assert that this position is supported by the declaration filed under 37 CFR 1.132 (29 September 2004) by staff scientist Ashkenazi. It claims that the purpose of the experiments that measured increases in gene copy number was to identify tumor cell markers useful for cancer treatment (pages 1-2, Declaration, 29 September 2004) and to identify cancers for which there was an absence of gene product over-expression (page 2). The Ashkenazi declaration further argues that, even when amplification of a gene in a tumor does not correlate with an increase in polypeptide expression, the absence of the gene product over-expression still provides significant information for cancer diagnosis and treatment.

Applicants argue (Response, 29 September 2004, page 19) that even if a prima facie case of lack of utility has been established, it should be withdrawn on consideration of the totality of the evidence. Applicants provide evidence in the form of a publication by Hanna et al. (attached to the Response of 29 September 2004).

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Applicants contend that the publication teaches that the HER-2/neu gene is over-expressed in breast cancers, and teaches that diagnosis of breast cancer includes testing both the amplification of the HER-2/neu gene as well as over-expression of the HER-2/neu gene product. Applicants argue that the disclosed assay leads to a more accurate classification of the cancer and a more effective treatment of it. The examiner agrees. In fact, Hanna et al. supports the instant rejection, in that Hanna et al. show that gene amplification does not reliably correlate with polypeptide over-expression, and thus the level of polypeptide expression must be tested empirically.

Applicants' arguments and declarations have been fully considered but are deemed not to be persuasive. In the instant application gene expression studies were conducted using pooled samples of normal and tumor tissues. With reference to Grimaldi reference, this appears to be declarant's own opinion, and is not supported by fact or evidence. In addition, there is no data on the PRO1277 polypeptide expression. The specification describes only mRNA expression data. There is no nexus with PRO1277 polypeptide. The argument presented evinces that instant specification provides a mere invitation to experiment, and not readily available utility. The declaration does not provide data such that the examiner can independently draw conclusions. In addition, there is no evidentiary art that would corroborate for example, that "any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue." Furthermore, as indicated above the literature cautions researchers against drawing conclusions based on small changes in transcript expression levels

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between normal and cancerous tissue (see and Hu et al discussions above). It is also not known whether PRO1277 polypeptide is expressed in normal esophagus or normal skin tissue, and what the relative levels of expression are. In the absence of any of the above information, all that the specification does is present evidence that the mRNA encoding PRO1277 is expressed at higher levels in normal esophagus or normal skin compared to esophageal tumor or melanoma tumor tissues, and invite the artisan to determine the rest of the story. This is further borne out by Grimaldi assertion that "additional studies can then be conducted if further information is desired" (Appendix A, paragraph 7). Such is insufficient to meet the requirements of 35 U.S.C. § 101 utility for the claimed protein.

Although, Dr. Polakis states that it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded polypeptide, it is important to note that the instant specification provides no information regarding differential mRNA levels of PRO1277 in tumor samples as contrasted to normal tissue samples or the corresponding protein levels. Only mRNA expression data is presented. Therefore, the declaration is insufficient to overcome the rejection of claims 1-8 and 11-13 based upon 35 U.S.C. § 101 and 112, first paragraph, since it is limited to a discussion of data regarding the correlation of mRNA levels and polypeptide levels. Furthermore, the declarations do not provide data such that the examiner can independently draw conclusions. Finally, it is noted that the literature cautions researchers from drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue. For example, as discussed

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above, Hu et al. (2003, Journal of Proteome Research 2:405-412) analyzed 2286 genes that showed a greater than 1-fold difference in mean expression level between breast cancer samples and normal samples in a microarray (p. 408, middle of right column) and discovered that, for genes displaying a 5-fold change or less in tumors compared to normal, there was no evidence of a correlation between altered gene expression and a known role in the disease. However, among genes with a 10-fold or more change in expression level, there was a strong and significant correlation between expression level and a published role in the disease (see discussion section). In addition, as discussed above Chen et al. disclose that the correlation between mRNA expression and protein expression is poor at best.

The declaration of Ashkenazi appears to argue that even if there was no correlation between gene expression and increased or decreased protein expression for PRO1277, the polypeptide encoded by a gene that is over-expressed or under expression in cancer would still have credible, specific and substantial utility. The examiner agrees that evidence regarding lack of over-expression would be useful. However, there is no evidence as to whether the gene products (such as the polypeptide) are over-expressed or not. Further research is required to determine such. Thus, the asserted utility is not substantial.

Although, Applicants agree that Sen reference teaches that most cancerous tissues are aneuploid, it is argued on page 13, last paragraph of remarks that there is no relevance to the expression levels and to the state of aneuploidy of the tumor cells with respect to the asserted utility. Applicants claim regardless of the cause of the

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differential expression, the fact that there is a higher level or lower level of expression PRO1277 gene in the normal esophagus or normal skin compared to esophageal tumor or melanoma tumor tissue allows this gene expression to be used as a diagnostic tool. These arguments have been fully considered but are found to be partially persuasive because the Office accepts that aneuploidy has no relevance to the differential expression of the mRNA of the instant invention. However, the lack of information on the record whether the claimed protein (PRO1277) is expressed at all in esophagus and skin tissue, cancerous or otherwise would make significant further research a necessity.

At page 14, Applicants assert that they have established that the accepted understanding in the art is that there is a direct correlation between mRNA levels and the level of expression of the encoded protein. It is also asserted that the Office relying on Pennica et al reference is also stating that data pertaining to PRO1277 polynucleotides do not necessarily indicate anything significant regarding the claimed PRO1277 polypeptides. These arguments have been fully considered but are not found to be persuasive. Haynes et al., and Chen et al. teachings listed above and discussed contradict Applicants assertion that there exists a direct correlation between mRNA levels and the level of expression of the encoded protein. In fact, the literature cautions researchers against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissues. Although, Applicants indicate on p.14 that there is a well established correlation in the art that the level of protein is positively correlated to the level of mRNA, as indicated above Haynes et al., and Chen et al. polypeptide levels cannot be accurately predicted from mRNA levels. Therefore,

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there is no evidence to support Applicants' assertion that there is working hypothesis among those skilled in the art is that there is a direct correlation between mRNA levels and protein levels. The declarations and cited references do not establish a substantial utility for the claimed PRO 1277 polypeptide molecules. As stated above, the specification does not provide sufficient guidance to the skilled artisan to diagnose or treat any disease.

Therefore, all of these reasons, the rejection of claims 1-13 based upon 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph as set forth in the last Office Action is maintained.

35 USC § 112, first paragraph – Written Description, maintained.

13. Claims 1-5, 12 and 13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The reasons for this rejection under 35 U.S.C. § 112, first paragraph, are set forth at pp. 9-12 of the previous Office Action (28 June 2004). Briefly, the Applicants were not in possession of all or a significant number of polypeptides that have 80-99% homology to SEQ ID NO: 34 and still retain the function of SEQ ID NO: 34.

Applicants discuss the legal standards applied when evaluating Written Description, including the requirement that written description depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure (page 21, 29 September 2004). The examiner takes no issue with the

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discussion of general requirements for evaluating Written Description in this case.

However, Applicants have not described or shown possession of all polypeptides 80-99% homologous to SEQ ID NO: 34, that still retain the function of SEQ ID NO: 34. Nor have Applicants described a representative number of species that have 80-99% homology to SEQ ID NO: 34, such that it is clear that they were in possession of a genus of polypeptides functionally similar to SEQ ID NO: 34.

As discussed in the previous Office Action (28 June 2004) even a very skilled artisan could not envision the detailed chemical structure of all or a significant number of encompassed PRO1277 polypeptides, and therefore, would not know how to make or use them. Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method of making. The claimed product itself is required. Recitation of the phrase "wherein the polypeptide is more highly expressed in normal esophagus or normal skin compared to esophageal tumor or melanoma tissue respectively, or wherein the said isolated polypeptide is encoded by a polynucleotide that is more highly expressed in normal esophagus or normal skin compared to esophageal tumor or melanoma tissues," (amended claims, 29 September 2004), is not adequate to describe polynucleotides encoding the PRO1277 polypeptides that have 80-99% homology to the PRO1277 polypeptide, since there was no reduction to practice to support the amended claims. Specifically, there is no way of knowing which, if any variants would have the same property of overexpression in the specific tissues. There is no nexus between the degree of homology and regulation of gene expression. Until one identifies a particular variant that is overexpressed or not, one of

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skilled in the art would not know the expression profile of the variant. The mere sequence alone will not allow one of skilled in the art to predict expression. Applicants made no variant polypeptides, and as recited in the current Written Description Guidelines, Applicants must have invented the subject matter that is claimed and must be in "possession" of the claimed genus (Federal Register, 2001, Vol. 66, No. 4, pages 1099-1111, esp. page 1104, 3rd column).

Claim Rejections - 35 USC § 102, withdrawn

14. Applicants arguments with respect to the rejection of claims 1-10 under 35 U.S.C. 102(b) as being anticipated by Sulston et al. (Accession NO: Q9UDNO or AAF19243, Pub. Date December 21, 1999) is withdrawn. Although, Applicants claim to earlier priority is denied (August 24, 2000, based on PCT US00/23328) for reasons discussed in paragraph 9 above, because Applicants have disclosed the polypeptide of the instant invention previously in Figures 1 and 2A-C in 60/097954 (without utility and enablement) the rejection is with drawn. Sulston et al. disclosed only the amino acid without utility. Therefore, the rejection of claims 1-10 as being anticipated by Sulston et al is withdrawn.

15. No Claims are allowed.

16. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jegatheesan Seharaseyon whose telephone number is 571-272-0892. The examiner can normally be reached on M-F: 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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